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10/566,945	06/28/2006	Patrick Bauban	324-184	3044
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/566,945

Applicant(s)

BAUBAN ET AL.

Examiner

TECHANE J. GERGISO

Art Unit

2437

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3 and 5-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/CDC)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. This is a Final Office Action in response to the applicant's communication filed on April 02, 2009.
2. Claims 1-3 and 5-20 have been examined and are pending.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-3, 7-8, 10 and 11-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 11 recite "An authentication server for automatically selecting one of a plurality of authentications" and "An authentication server arrangement. Use of the word "server" or "authentication server" does **not** necessarily mean that the claim is directed to a machine. Only if at least one of the claimed elements of the server is a **physical part of a device** can the server as claimed constitute part of a device or a combination of devices to be a machine within the meaning of 101. Claim 1 is directed to comprise [a reception arrangement; a **selector arrangement for** selecting an authentication identifier in a memory and an **authentication arrangement for** authenticating said user and a redirector], claim 11 is directed to server arrangement including a receiver arrangement, selector arrangement, authenticator arrangement

and connector redirector arrangement for respectively performing receiving, selecting, authenticating and redirecting connection; and these claimed elements are not a processes occurring as a result of executing the software program, not a machine programmed to operate in accordance with the software program, not a manufacturer structurally and functionally interconnected with the program in a manner which enables the software program to act as a computer component and realize its functionality. They are also clearly not directed to a composition of matter. Therefore, claims 1 and 11, **to those of ordinary skill in the art, may all be reasonably implemented as a software routines** and therefore claims 1 and 11 are rejected as **an authentication server of software or program per se**, failing to fall within a statutory category of invention and rejected as non-statutory under 35 USC 101. Claims 2, 3, 7, 8 and claims 12-19 are also failing to fall within a statutory category of invention and rejected as non-statutory under 35 USC 101 with a s similar rationale give above to reject their corresponding independent claims.

[See the applicant's disclosure for indicating the invention implemented as a program: 0075 and Figure 1: Authentication Server SA]: **"the invention applies equally to a computer program adapted to implement the invention, in particular a computer program on or in an information medium.** This program may use any programming language and be in the form of source code, object code, or an intermediate code between source code and intermediate code, such as in a partially compiled form, or in any other form suitable for implementing a method of the invention".

Claim 10 recites “A physical information medium”. Claim 10 is directed to a program itself, not a process occurring as a result of executing the program, a machine programmed to operate in accordance with the program nor a manufacturer structurally interconnected with the program in a manner which enables the program to act as a computer component and realize its functionality. The physical information medium include programs to receiver identifier, select an authentication identifier, authenticate and redirect connection. In addition, the “physical information medium” would suggest to one of ordinary skill *signals or other forms of propagation and transmission media, typewritten or handwritten text on paper, or other items* failing to be an appropriate manufacturer under 35 USC 101 in the **context of computer-related inventions** [See the applicant’s disclosure for medium : 0075 and 0077 Moreover, the information medium may be a transmissible medium such as an electrical or optical signal, which may be routed via an electrical or optical cable, by radio or by other means. The program of the invention may in particular be downloaded over an internet type network.]. Therefore, claim 10 fails to fall within a statutory category of invention and rejected as non-statutory under 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

5. Claims 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The limitation in the claims “wherein **there is no connection** between the user terminal and the authentication server **during the receiving, selecting, authenticating and redirecting steps**” does not have support in the original disclosure as filed for the above negative limitation. The applicant's also did not provide specific section or paragraph of the discourse in support of the above negative limitation.

[MPEP 2173.05(i) Negative Limitations]. Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. The claims containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

Response to Arguments

6. Applicant's arguments filed on April 02, 2009 have been fully considered but they are not persuasive.

The applicant argues that by amending claims 1, 10 and 11, the applicant suggests the claims comply with 35 USC 101. However, the applicant did not provide any substantial or persuasive argument or rationale to overcome the 101 rejection and the claims remain rejected as non-statutory under 35 USC 101.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., Claim 1 indicates that there is only one authentication server which is distinct from the service servers, i.e., which is not included in a service server.

and

for each service request in claim 1, no connection between the terminal and the service server designated by the selected provider identifier is established.)

are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

For at least the above reasons, the applicant's arguments are not persuasive to overcome the prior arts in record and place the independent claims in condition for allowance including their corresponding dependent claims.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3 and 5-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawa et al. (hereinafter referred to as, Sawa, US Pub. No.: 2003/0097593) in view of Ritola et al. (hereinafter referred to as Ritola, US Pub. No.: 2005/0289341).

As per claim 1:

Sawa discloses an authentication server for automatically selecting one of a plurality of authentications identified respectively by authentication identifiers in order to authenticate a user of a terminal in order to authorize the user to access a service dispensed by one of a service server of providers identified respectively by provider identifiers via a communication network the server comprising:

a reception arrangement for receiving from said terminal a provider identifier selected in said terminal in response to a connection set up between said user terminal and said authentication server (0053; web server receive),

a selector arrangement for selecting an authentication identifier in a memory as a function of the type of at least one of said terminal and said communication network (0044; 0048; 0049; 0053; 0056: an authentication method suitable for the user terminal is selected, by using the data of a request for service from a user terminal and various types of authentication methods are supported, and accordingly various types of terminals can be supported. The terminal information object preparation process, the carrier or communication employer and type of user terminal that issues an HTTP request are specified).

an authenticator arrangement for authenticating said user by using an authentication process associated with said selected authentication identifier (0058; 0059: Using the determined

authentication method, various types of data, for example, a user's name, passwords, etc., required for the authentication process are obtained, and an authentication database is accessed, thereby checking the validity of a user terminal).

Sawa does not explicitly teach the authentication identifier as a function of the selected provider identifier and a redirection arrangement for redirecting said connection with said terminal to a service server corresponding to said selected provider identifier if said user has been authenticated. Ritola, in analogous art, however teaches the authentication identifier as a function of the provider identifier (0048; 0051; 0052; provides service if authentication by identity provider identifier corresponding to each service provider stored in memory of the terminal is successful) and a redirection arrangement for redirecting said connection with said terminal to a service server corresponding to said selected provider identifier if said user has been authenticated (0015; 0048). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Sawa to include the authentication identifier as a function of the provider identifier and a redirection arrangement for redirecting said connection with said terminal to a service server corresponding to said selected provider identifier if said user has been authenticated. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to provide a reliable and more secure automated authentication method and system from a service provider's authentications request without a user intervention as suggested by Ritola in (0005; 0006).

As per claims 2 and 12:

Sawa discloses the authentication server, wherein said selector arrangement is arranged to select said authentication identifier as a function of an authentication security level (0058: set selected authentication method with a high security level as the authentication method with high priority). Sawa does not explicitly teach authentication identifier a function to said selected provider identifier. Ritola, in analogous art, however teaches authentication identifier in corresponding relationship to said selected provider identifier (0048; 0051; 0052; provides service if authentication by identity provider identifier corresponding to each service provider stored in memory of the terminal is successful). See motivation given in claim 1.

As per claims 3 and 13:

Sawa discloses an authentication server, wherein said selector arrangement is arranged to select said authentication identifier as a function of authentication rules associated with and applied to at least an authentication security level corresponding to said terminal type and said communication network type (0069-0070; matrix for determining authentication method in the authentication method decision process). Sawa does not explicitly teach authentication identifier a function to said provider identifier. Ritola, in analogous art, however teaches authentication identifier in corresponding relationship to said provider identifier (0048; 0051; 0052; provides service if authentication by identity provider identifier corresponding to each service provider stored in memory of the terminal is successful). See a motivation given in claim 1.

As per claims 5 and 14:

Sawa does not explicitly teach an authentication server, wherein said selector arrangement is arranged to transmit to said terminal a list of services identified by service identifiers in response to said connection set up between said user terminal and said authentication server, and said user terminal is arranged to transmit to said selector arrangement a service identifier of a service selected by said user in the transmitted list in order for said authentication server to select said authentication identifier as a function also of said selected service identifier. Ritola, in analogous art, however teaches an authentication server, wherein said authentication server is arranged to transmit to said terminal a list of services identified by service identifiers in response to said connection set up between said user terminal and said selector arrangement, and said user terminal is arranged to transmit to said selector arrangement a service identifier of a service selected by said user in the transmitted list in order for said selector or arrangement to select said authentication identifier as a function also of said selected service identifier (Figure 5: 51 select different single sign authentication module corresponding to each service provider by selecting identity provider 57; Figure 4: identity provider identifier authentication request and response communication between terminal and service provider).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Sawa to include an authentication server, wherein said authentication server is arranged to transmit to said terminal a list of services identified by service identifiers in response to a connection set up between said user terminal and said authentication server, and said user terminal is arranged to transmit to said selector arrangement a service identifier of a service selected by said user in the transmitted list in order for said authentication server to select said authentication identifier as a function also of

said selected service identifier. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to provide a reliable and more secure automated authentication method and system from a service provider's authentications request without a user intervention as suggested by Ritola in (0005; 0006).

As per claims 6 and 15:

Ritola discloses the authentication server, wherein said authentication server is arranged to transmit said user terminal a list of provider identifiers in response to a connection set up between said user terminal and said selector arrangement and said terminal is arranged to transmit to said selector arrangement a provider identifier selected by said user in the transmitted list in order for said selector arrangement to select said authentication identifier as a function of said selected provider identifier (0051; 0052: IDP displays a list of identity providers that are acceptable by service provider and terminal; a user selects a particular provider identifier and sends an authentication request).

As per claims 7 and 16:

Sawa discloses the authentication server, wherein, if said user has been authenticated, the authenticator arrangement is arranged to transmit to said service server said terminal type, said communication network type, said transmitted service identifier, and a security level of the authentication associated with said selected authentication identifier (0095; 0096; 101; terminal information object cache).

As per claims 8 and 17:

Sawa discloses an authentication server, further comprising two separate servers respectively including said selector arrangement and said authenticator arrangement (0051; 0052; mobile agent server; web server, and mobile agent; mobile agent for selecting an authentication method).

As per claim 9:

Sawa discloses a method in an authentication server of automatically selecting one of a plurality of authentications identified respectively by authentication identifiers in order to authenticate a user of a terminal to authorize said user to access a service dispensed by one of service servers of a providers identified respectively by a provider identifiers via a communication network, the method comprising:

receiving from said terminal a provider identifier selected in said terminal in response to a connection set up between said user terminal and said authentication server (0053; web server receive),

selecting an authentication identifier in a memory as a function of the type of at least one of said terminal and said communication network (0044; 0048; 0049; 0053; 0056: an authentication method suitable for the user terminal is selected, by using the data of a request for service from a user terminal and various types of authentication methods are supported, and accordingly various types of terminals can be supported. The terminal information object preparation process, the carrier or communication employer and type of user terminal that issues an HTTP request are specified), and

authenticating said user by an authentication process associated with said selected authentication identifier (0058; 0059: Using the determined authentication method, various types of data, for example, a user's name, passwords, etc., required for the authentication are obtained, and an authentication database is accessed, thereby checking the validity of a user terminal).

Sawa does not explicitly teach the authentication identifier as a function of the provider identifier and redirecting said connection with said terminal to a service server corresponding to said selected provider identifier if said user has been authenticated. Ritola, in analogous art, however teaches the authentication identifier as a function of the provider identifier (0048; 0051; 0052; provides service if authentication by identity provider identifier corresponding to each service provider stored in memory of the terminal is successful) and redirecting said connection with said terminal to a service server corresponding to said selected provider identifier if said user has been authenticated (0015; 0048). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Sawa to include the authentication identifier as a function of the provider identifier and redirecting said connection with said terminal to a service server corresponding to said selected provider identifier if said user has been authenticated. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to provide a reliable and more secure automated authentication method and system from a service provider's authentications request without a user intervention as suggested by Ritola in (0005; 0006).

As per claim 10:

Sawa discloses a physical information medium; adapted to be loaded into and executed by an authentication server, the medium including a program for enabling the authentication server to automatically select one of a plurality of authentications respectively identified by authentication identifiers in order to authenticate a user of a terminal in order to authorize said user to access a service dispensed by one of service servers of providers identified respectively by provider identifiers via a communication network, said program including program instructions for enabling the authentication server to:

receiving from said terminal a provider identifier selected in said terminal in response to a connection set up between said user terminal and said authentication server (0053; web server receive),

selecting an authentication identifier in a memory as a function of the type of at least one of said terminal and type of said communication network (0044; 0048; 0049; 0053; 0056: an authentication method suitable for the user terminal is selected, by using the data of a request for service from a user terminal and various types of authentication methods are supported, and accordingly various types of terminals can be supported. The terminal information object preparation process, the carrier or communication employer and type of user terminal that issues an HTTP request are specified), and

authenticating said user by an authentication process associated with said authentication identifier (0058; 0059: Using the determined authentication method, various types of data, for example, a user's name, passwords, etc., required for the authentication process are obtained, and an authentication database is accessed, thereby checking the validity of a user terminal).

Sawa does not explicitly teach the authentication identifier as a function of the provider identifier and redirecting said connection with said terminal to a service server corresponding to said selected provider identifier if said user has been authenticated. Ritola, in analogous art, however teaches the authentication identifier as a function of the provider identifier (0048; 0051; 0052; provides service if authentication by identity provider identifier corresponding to each service provider stored in memory of the terminal is successful) and redirecting said connection with said terminal to a service server corresponding to said selected provider identifier if said user has been authenticated (0015; 0048). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Sawa to include the authentication identifier as a function of the provider identifier and redirecting said connection with said terminal to a service server corresponding to said selected provider identifier if said user has been authenticated. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to provide a reliable and more secure automated authentication method and system from a service provider's authentications request without a user intervention as suggested by Ritola in (0005; 0006).

As per claim 11:

Claim 11 is a data processor arrangement for performing the method of claim 9. Therefore, claim 11 is rejected with a similar rationale and reason given above to reject claim 9 as being unpatentable over Sawa in view of Ritola.

As per claim 18, 19 and 20

Sawa discloses there is no connection between the user terminal and the authentication server during the receiving, selecting, authenticating and redirecting steps (0026; provided from cache service).

Conclusion

9. The prior arts made of record and not relied upon are considered pertinent to applicant's disclosure. See the notice of reference cited in form PTO-892 for additional prior arts.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TECHANE J. GERGISO whose telephone number is (571)272-3784 and fax number is (571) 273-3784. The examiner can normally be reached on between 9:00am - 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Techane J. Gergiso/

Examiner, Art Unit 2437

/Emmanuel L. Moise/

Supervisory Patent Examiner, Art Unit 2437

